

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Miraj Mostafa
Title: DATA TRANSMISSION
Appl. No.: 09/990,359
Filing Date: 11/23/2001
Examiner: Truong, Cam Y T
Art Unit: 2169
Confirmation Number: 2084

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

The Examiner has finally rejected claims 1-7, 9-16 and 19-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0056123 to Liwerant et al. (hereinafter “Liwerant”), in view of U.S. Patent No. 6,738,822 to Fukasawa et al. (hereinafter “Fukasawa”) and further in view of the newly cited U.S. Patent Publication No. 2009/0109959 to Elliot et al. (hereinafter “Elliot”). Applicant respectfully disagrees with the Examiner’s position and, therefore, traverses these rejections for at least the reasons that follow.

Embodiments of the present invention provide for formation and transmission of notification messages in accordance with the multimedia message reception capabilities or user preferences. Claim 1 of the present information recites "... receiving media content in a network entity from a sending entity and addressed to at least one recipient." Once the media content is received at the network entity, in accordance with embodiments of the invention and as recited in pending claim 1, a network entity accesses a database comprising data related to the reception capabilities or preferences of an intended recipient of media content. The network entity then forms a notification message containing information related to the media content in accordance with the reception capabilities or preferences of the intended recipient. Thus, in accordance with embodiments of the present invention, media content is sent to a recipient, and at least components of that content are translated according to recipient preferences, which may be located on a database that is in communication with the MMSC. Accordingly, independent claim 1 recites "accessing, by the network entity, a database comprising recipient data describing at least one of multimedia reception capabilities and multimedia reception preferences for at least one recipient" Each of independent claims 11, 12, 13 and 23 recites a similar feature.

As noted in Applicant's earlier responses, Liwerant and/or Fukasawa fail to teach or suggest at least the above noted features of the pending claims. The Examiner also acknowledges that neither Liwerant nor Fukasawa describe "a network entity [that] communicates with at least one addressed recipient over a radio communication network; accessing, by the network entity, a database comprising recipient data describing at least one of multimedia reception capabilities and multimedia reception preferences for at least one recipient; and in accordance with said at least one of multimedia reception capabilities and reception preferences." See Office Action, dated January 26, 2010, page 4, line 21 to page 5, line 4. However, the Examiner is relying on Elliot, paragraphs [1545], [2533], [2720], [2721] and Fig. 110, to assert that Elliot describes the above noted features of the pending claims. See Office Action, dated January 26, 2010, page 5, line 5 to page 7, line 7. Applicant respectfully disagrees.

In particular, paragraph [1545] of Elliot describes:

“[1545] The user is able to create and modify recipient address information through his interface PC software. The user is able to record multiple types of addresses in his address book, including 10 digit ANIs, voice mailbox ids, fax mailbox ids, paging numbers and email addresses (MCIMail and Internet). This information is saved onto the PC. The address information retained on the PC Client is classified and sorted by recipient's name.” (Emphasis added.)

As clarified in paragraph [1544] of Elliot, the recipient information is stored in an address book that can be accessed by a user and edited if necessary. Paragraph [1545] of Elliot then describes that a user, through a user interface, can manually add and/or edit the phone number, fax number, etc., associated with the recipient. In summary, the above-noted sections of Elliot describe how a recipient's contact information can be manually modified by a user. Such modifications to the address book entries that are described in Elliot's disclosure are, however, considerably different from the disclosed embodiments of the present application and the features of the pending claims for several reasons.

First, the contact information that is described in Elliot's disclosure is merely used to initiate contact with a recipient. However, such initial contact information does not constitute “recipient data describing at least one of multimedia reception capabilities and multimedia reception preferences,” which recited in pending claim 1. As recited in claim 1, accessing such multimedia reception capabilities and preferences occurs after “receiving media content ...from a sending entity and addressed to at least one recipient.” Therefore, the address of the recipient is already known by the sender since the media content, according to claim 1, has been addressed to at least one recipient. Claim 1 further recites that, subsequent to sending the media content to the addressed recipient, data describing multimedia reception capabilities and preferences are accessed from a database. Therefore, the multimedia reception capabilities and preferences that are recited in pending claim 1 are clearly different from the phone number, fax number, etc. that are described in Elliot since the latter merely allows the phone call to be directed to the intended recipient.

Second, the description in paragraph [1545] of Elliot describes manual operations of a user that includes using a user interface (UI) to edit phone numbers. In contrast, the features of the pending claims do not recite such manual interventions by a user. As noted above, the

operations that are recited in claim 1 occur after the media content has been received by a network entity. As a result, such manual user interventions are not recited in pending claim 1.

Third, in order for a user (which is described in Elliot's paragraph [1545]) to edit a phone number, fax number or other contact information associated with the recipient, the user must know the exact contact information. For this reason, construing multimedia reception capabilities and preferences that are recited in pending claim 1 with such contact information of Elliot would be inconsistent with the embodiments of the present invention. In particular, the originally filed specification at, for example, page 6, lines 1-4, describes:

“An MMS user agent has no means of knowing the exact capabilities of other UAs, and thus, a UA-generated notification might not serve the purpose in many cases, especially in the case of an inter-MMSE (MMS Environment) situation.”

Therefore, according to the originally filed specification, a particular user agent (UA) cannot not know the exact capabilities and preferences of all other UAs. In contrast, in order to contact a recipient and/or to edit the recipient's contact information, the user must know the recipient's exact contact information. As such, the Examiner's assertions that the recipient's contact information can be reasonably interpreted as “multimedia capabilities and preferences” since a user must exactly know the former, whereas the latter is not exactly known to the user.

As to paragraphs [2720] and [2721] of Elliot, these sections of Elliot similarly describe a user's manual operations related to entering a recipient's contact information to create a list (i.e., an address book entry). As noted above, such operationd cannot be construed as “accessing, by the network entity, a database comprising recipient data describing at least one of multimedia reception capabilities and multimedia reception preferences for at least one recipient,” which is recited in pending claim 1.

As to paragraph [2533] and Fig. 110 of Elliot, the Examiner is relying on these sections of Elliot to argue that this reference describes a radio network. See Office Action, dated January 26, 2010, page 5, lines 6-18. Applicant respectfully disagrees, as there are no descriptions of a radio network in these sections of Elliot.

For at least the above noted reasons, Elliot fails to cure the deficiencies of Liwerant and/or Fukasawa. Therefore, a *prima facie* case of obviousness has not been established. Accordingly claim 1 is patentable.

Claims 11, 12, 13 and 23 recite similar features as the ones discussed in connection with claim 1. Accordingly, claims 11, 12, 13 and 23 are patentable for similar reasons as claim 1.

Further, claims 2-7, 9, 10, 14-16 and 19-22 each depend, either directly or indirectly, from one of allowable claims 1, 11, 12 or 13 and are, therefore, patentable for at least that reason, as well as for additional patentable features when those claims are considered as a whole.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date June 28, 2010

By /Sanjeev K. Dhand/

FOLEY & LARDNER LLP
Customer Number: 30542
Telephone: (858) 847-6735
Facsimile: (858) 792-6773

G. Peter Albert Jr., Reg. No. 37,268
By Sanjeev K. Dhand, Reg. No. 51,182
Attorney for Applicant